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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,668	11/25/2003	Otto E. Anderhub	06530.0311	6222

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EXAMINER

DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/720,668

Applicant(s)

ANDERHUB ET AL.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 66-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3-2-04; 9-7-04; 5-16-05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Election/Restrictions

Claims 66-86 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12-15-2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50-52 and 56-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Turkel, et al.-5643307.

Turkel discloses a biopsy forceps including a proximal control handle 18, a distal end effector assembly including a 1st end effector 24 and a 2nd end effector 22. The 2nd effector includes a cutter portion 35 configured to mate with the cutting edge 25 on the 1st effector, and a holder 50. The holder receives the 2nd effector. The jaws are pivotally connected together. The holder holds cut tissue for biopsy. A groove in the holder 56 engages a projection 40 on the effector.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,4,10,12,15,17-19 and 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Paternuosto-WO 01/30242 A1 in view of Jaeger-4763669.

Paternuosto discloses a forceps having a first jaw 10a and a second jaw 10b. The second jaw has a cutting edge 12, a holder (rest of 10b shown in fig. 7) and a storage portion 22. The storage portion has holes 24. The holder portion has a groove shown in fig. 9 for receiving a lip on the storage portion. The two jaws are pivotally attached to each other. Each of the jaws has a sharpened cutting edge for mating together to cut tissue. The storage portion receives the cut tissue for biopsy. The examiner contends that the holder portion is configured to receive the cutting portion because it is integral therewith and since it does receive it, or is attached to it, it therefore is configured to receive it. The claim is not limited to some means to receive it. However, in any event, if it is not deemed to disclose this limitation, the examiner turns to Jaeger. Jaeger teaches that it was known to removably attach a cutting edge to a biopsy forceps in order to be re-sharpened see col. 2 lines 33-36. The means is a slot or groove in the holder or jaw. Therefore, it would have been obvious to have removably attached the blade edge 12 of Paternuosto to the rest of the holder of the jaw, in order to allow for sharpening.

Claims 3,6-9,11,13,14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paternuosto in view of Jaeger-'669.

Paternuosto discloses or makes obvious the invention as claimed with the exception of the specific cutter portion attachment means, or the materials of the different components.

Jaeger discloses a biopsy forceps as described above.

It would have been obvious to have provided the groove on the holder for receiving the cutter, as this has proven to be a convenient means for removably attaching the edge to the jaw for the purposes of sharpening the cutter. As for the different materials, same materials, metal, non-metal materials of the different components, the examiner contends that such is nothing more than a mere obvious design choice. Cutting edges were previously known as being manufactured out of plastic or metal. Forming two removable components out of different materials would allow for one material to be sharpened and the other material to be less expensive, for example.

Claims 16 and 26-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paternuosto-'242 in view of Jaeger-'669 and further in view of Kortenbach-5707392 or Kratsch, et al.-5478350.

Paternuosto as modified by Jaeger discloses the invention as claimed with the exception of the curved part of the tang and the proximal handle/control member. Kortenbach discloses a handle control as shown to be known prior art in fig. 1 and a curved tang section 61. It would have been obvious to have provided both of these on Paternuosto, as the end effector necessarily needs a means to open and close the jaws, and the bent tang allows for room for the control wire connections.

Kratsch discloses a proximal control handle 18 and a curved tang portion 206. It would have been obvious to have provided a curved tang in order to tailor the rate of closure of the jaws, and providing the control handle would have provided a means to open and close the jaws.

Claims 53-55,64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turkel, et al-'307.

Turkel discloses the invention as claimed with the exception of the materials and the sharp section on the 2nd effector. It would have been obvious to have provided a sharp edge on the 2nd effector to ensure clean cutting of the tissue. The choice of the claimed materials for the different components is nothing more than a mere obvious design choice. Cutting edges and jaws were previously known as being manufactured out of plastic or metal. The sleeve 50 (holder) is already disclosed as being made out of plastic.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Glen K Dawson
Primary Examiner
Art Unit 3731

Gkd
14 February 2007